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OFFICE OF PETITIONS

In re Application of :
Murphy, et al. :
Application No. 10/790,304 : ON PETITION
Filed: March 1, 2004 :
Attorney Docket No. RYLZ 2 00658-1 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 30, 2004, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of prior filed nonprovisional application no. 09/944,731.

This petition under 37 CFR 1.78(a)(3) is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2), and must be filed during the pendency of the nonprovisional application. In addition, the petition must accompanied by:

- (1) the surcharge as set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional; and
- (3) the reference to the prior filed provisional application, supplied in an application data sheet, or as an amendment in the first sentence of the specification following the title.

The instant nonprovisional application was filed on March 1, 2004. A reference to the prior filed nonprovisional application was included in the application transmittal letter.

Where a claim for priority under 37 CFR 1.78(a)(2) is not included in the first sentence of the specification or in an Application Data Sheet but does appear either in the oath or declaration or a transmittal letter filed with the application **and the Office notes the claim for priority**, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2). However, on the other hand, if the USPTO does not note the claim for priority to the provisional application in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).¹

In the instant case, the Office noted the claim for priority of the nonprovisional application.

Accordingly, the \$130 fee submitted for the petition is unnecessary and has been refunded to Deposit Account No. 06-0308. Please note, however, that a petition under 37 CFR 1.78 requires a fee of \$1,370, subject to small entity reduction.

This application is being returned to Group Art Unit 1724 for examination in due course.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Cliff Congo at 571-272-3207.



Charles Pearson
Director
Office of Petitions

¹ See 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.